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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/009,353 | 11/13/2001 | Steven G. Corveleyn | 55728US002 | 1999 |

32692 7590 03/14/2005

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| EXAMINER |
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RAJGURU. UMAKANT K

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| ART UNIT | PAPER NUMBER |
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1711

DATE MAILED: 03/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/009,353
Filing Date: November 13, 2001
Appellant(s): CORVELEYN, STEVEN G.

Dean M. Harts
For Appellant

EXAMINER'S ANSWER

MAILED

MAR 14 2005

GROUP 1700

This is in response to the appeal brief filed October 05, 2004.

(1) Real Party in Interest

Art Unit: 1711

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

This appeal involves claims 16, 17, 19, 20 and 21.

Claims 1-15 and 23-26 are withdrawn from consideration as not directed to the elected invention.

WR Claims 13, 18 & 22^{have} been canceled.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Art Unit: 1711

The rejection of claims 16, 17, 19, 20 and 21 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

4485062

DAWES ET AL

11-1984

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 16, 17 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dawes et al (US 4485062).

Dawes discloses a process for extruding polymers (abstract), Fluoroelastomers are one class of such polymers (col. 4, lines 19-21). Carbon black and some inorganic materials can be added to polymers (col. 4, lines 26-35). Mineral oils can be incorporated into the polymers (col. 5, lines 15, 28-32).

Dawes does not mention anything about wax content of mineral oil. It is reasonable to assume that the wax content is less than 2 parts per 100 parts by wt. of composition (as claimed), since the oil of Dawes is a mineral oil used at a low amount of 0.03% by wt (col. 5, line 2).

It would have been obvious to follow teachings of Dawes to arrive at instant invention.

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Instant claims encompass a composition. The ingredients that it contains define a composition. Dawes discloses a composition that contains all the (claimed) ingredients. According to the examiner it is immaterial whether fluoroelastomer and mineral are blended or simply brought in contact with each other (as taught by prior art). Additionally one of ordinary skill in the art will easily notice the Dawes uses mineral oil essentially as a lubricant. A lubricant is known to be admixed with a polymeric matrix and there are numerous lubricants used in admixture with other ingredients of a composition. Hence, as stated in earlier office action, the teachings of Dawes would have provided enough incentive to one to arrive at instant invention.

Instant claims are directed to a composition.. Recitation, in instant claim 16, "blended with" is a process limitation.. Determination of patentability in "product-by-process" claims is based on product itself even though such claims are limited and defined by process and thus the product in such claims/s is unpatentable if it is same as or obvious from the product of prior art even if prior art product was made by a different process.

(11) Response to Argument

Appellant's arguments starting on page 7 of this appeal brief seem to be far more directed to a process than to a composition. It has been clarified by the examiner earlier that, such arguments are not persuasive to obviate the rejection of claims directed to composition. Dawes discloses a composition, which comprises the claimed ingredients. It should be noted that claims 8-15 & 23-26 which are directed to a process have been withdrawn from consideration.

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Appellant's another argument on page 12, that "according of Dawes in col. 4, lines 65-67, the fluoroclastomer and low viscosity liquid do not get mixed" is also not persuasive for the above reasons. The examiner's position is that it is immaterial whether they get mixed or not.

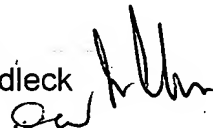
Appellant on page 14, or refers to the term "blend with" as a structural characteristic. Here again instant claims are not directed to a structure or an article. If they were, the examiner would have restricted them as being directed to a different invention.

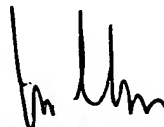
Claims 16, 17 and 19-21 are therefore prima facie obvious.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Rajguru/LR
February 28, 2005

Conferees
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